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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/819, 669 03/17/97 BOON

T LUD-5253.5-D

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HM12/0926

EXAMINER

GAMBEL, P

ART UNIT	PAPER NUMBER
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1644

32

DATE MAILED:

09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application N 08/819669	Applicant(s) BOON ET AL.
	Examiner GAMBEL	Group Art Unit 1644

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 173, 174, 176, 179, 181, 182 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) 173, 174, 179, 181 is/are allowed.
- Claim(s) 176, 182 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- Information Disclosure Statement(s); PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

### DETAILED ACTION

1. Applicant's communications, filed 6/30/00, 7/10/00 and 7/14/00 (Paper Nos. 29/30/31) are acknowledged.

Claims 1-172, 175, 177, 178 and 180 have been canceled previously.

Claims 173, 174, 176, 179, 181 and 182 are pending.

2. The text of those sections of Title 35 USC not included in this Action can be found in a prior Action.

This Office Action will be in response to applicant's arguments, filed 6/30/00 (Paper No. 29).

The rejections of record can be found in the previous Office Action (Paper No. 27).

3. Applicant's comments on an Interview dated 12/22/98; applicant's response, filed 2/1/99; Office Letter, date 8/31/99; the present examiner's comments on these previous communications, are acknowledged.

While applicant states that an explanation is needed and requested; it is not clear what applicant is requesting. Applicant raised similar issues at the Interview, held on 9/7/99 (Paper No. 23), with the current examiner and two of the same examiners that were present 12/22/98 (Paper No. 17). It appeared that applicant's concerns were addressed at this subsequent Interview and that all agreed to further prosecute the instant application and claims.

An Office Action, was mailed 12/27/99 (Paper No. 27) and applicant's communications, filed 6/30/00, 7/10/00 and 7/14/00 (Paper Nos. 29/30/31) are in response to this Office Action.

This Office Action is in response to the applicant's communications filed 6/30/00, 7/10/00 and 7/14/00 (Paper Nos. 29/30/31).

Applicant is invited to clearly indicate what further information needs to be clarified in view of the current prosecution on the instant application.

It is noted that an examiner is not prohibited from making a New Grounds of Rejection provided it is warranted during the prosecution of a patent application. Applicant has the options of appealing or petitioning the patent application.

Again, the examiner apologizes for any misunderstanding or inconvenience to applicant.

As pointed out previously, this Office Action addresses the current claimed invention and takes into account the prosecution history set forth in the instant file application

4. Applicant's Sequence submission, entered 7/18/00, is acknowledged and appears to be in compliance with the Sequence Rules

5. While it is acknowledged that both "BALB/C" and "BALB/c" are used in the literature to describe this mouse strain; applicant is reminded that "BALB/c" is the proper designation of this mouse strain (see pages 27-28).

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CAR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CAR 1.52(c).

The reference to USSN 07/764,364 in the oath appears in error, as this application issued as U.S. Patent No. 5,327,252 directed to a print apparatus.

Application Number 764,364 has the last "4" crossed out and "PCT/US92/04354 / 22 May 1992" has been crossed out.

Applicant will address the defective oath upon allowance.

7. Upon consideration of the Boon-Falleur / van der Bruggen / van den Eynde / Van Pel / De Plaen / Lurquin / Chomez Declaration under 37 C.F.R. § 1.132, filed 7/10/00 (Paper No. 30); the previous New Matter rejection under 35 U.S.C. § 112, first paragraph, and objection to under 35 U.S.C. 132, with respect to the current SEQ ID NOS: 7/8 has been withdrawn; given that the current SEQ ID NOS: 7/8 are based upon the same clones as that disclosed in the specification as filed.

8. Upon reconsideration, including applicant's arguments, filed 6/30/99 (Paper No. 29); the previous rejection under 35 U.S.C. § 103(a) as being unpatentable over van den Eynde et al. (Int. J. Cancer 44: 634-640, 1989) in view of art known methods of isolating antigens of interest as taught by de Plaen et al (PNAS 85: 2274-2278, 1988) AND/OR Brown et al. (U.S. Patent No. 5,141,742) AND/OR Seed et al. (U.S. Patent No. 5,506,126) and in further evidence by Van der Bruggen et al. (Science 254: 1643-1647, 1991) and Traversari et al. (Immunogenetics 35: 145-152, 1992) has been withdrawn; given that van den Eynde et al. only identified antigen E via cytotoxic T lymphocytes and did not isolate antigen E.

It is noted that Van der Bruggen et al. (Science 254: 1643-1647, 1991) and Traversari et al. (Immunogenetics 35: 145-152, 1992) were evidentiary references and not considered prior art references.

9. Claims 176 and 182 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 176 and 182 stand rejected in the recitation of "stringent conditions" because the metes and bounds of said conditions are not clearly defined. The term in claim is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the invention.

Applicant's arguments, filed 6/30/99 (Paper No. 29), have been fully considered but are not found convincing essentially for the reasons of record, reiterated herein for applicant's convenience.

Applicant asserts that there is a clear definition in the specification and relies upon the disclosure on page 48, paragraph 1 of the specification which states: "In the following examples, whenever "hybridization" is referred to, the stringency conditions used were similar to those described supra. "Stringent conditions" as used herein thus refers to the foregoing conditions; subject to routine, art recognized modification."

Here, this disclosure relies upon relative and ill-defined terms such as "similar" and "modification" and do provide a clear standard for ascertaining the requisite degrees of such similarities and modifications as it reads on tumor rejection antigens encoded by complementary nucleotides which hybridize under stringent conditions. Therefore, one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of the invention.

Applicant's arguments are not found persuasive.

Applicant is invited to recite specific conditions, as disclosed in the specification as filed in combination with functional language to obviate this rejection.

Applicant should specifically point out the support for any amendments made to the disclosure. See MPEP 714.02 and 2163.06

10. Claim 173, 174, 179 and 181 are allowable.

Claims 176 and 182 stand rejected.

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

*Phillip Gambel*

Phillip Gambel, PhD.

Primary Examiner

Technology Center 1600

September 25, 2000